



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,740	05/11/2001	Kenneth Arneson	20-485	5000
7590 12/03/2008 MANELLI DENISON & SELTER PLLC 2000 M Street, N.W., 7th Floor Washington, DC 20036-3307				
EXAMINER				
LASTRA, DANIEL				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
12/03/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/852,740

**Applicant(s)**

ARNESON ET AL.

**Examiner**

DANIEL LASTRA

**Art Unit**

3688

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 5-28 and 38-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-28 and 38-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1, 2, 5-28 and 38-41 have been examined. Application 09/852,740 (System and method for providing wireless services) has a filing date 05/11/2001 and Claims Priority from Provisional Application 60203885 (05/12/2000).

**Response to Amendment**

2. In response to Non Final Rejection filed 06/16/2008, the Applicant filed an Amendment on 09/16/2008, which amended claims 1, 9, 18, 21, 38.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, 5-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory

requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fail to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus).

### **Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman (US 6,980,670) in view of Katz (US 6,424,706).

As per claim 9, Hoffman teaches:

A method of providing e-commerce incentives, comprising:

*providing attraction to said given web site by offering said wireless airtime units to said user in response to said user having actively interacted with a given web site (see column 4, lines 3-25; column 5, lines 15-20; col 17, lines 45-60; col 28, lines 45-65; col 32, lines 15-30).*

Hoffman fails to teach that create a wireless service account in response to a user having actively interacted with a website of a seller of goods or services, said seller of goods or services securing wireless airtime units from a wireless service provider. However, Katz teaches that it is old and well known in the promotion art for a retail

vendor to offer users as bonus a fixed amount of telecommunication minutes for interacting with said retail vendor (see col 2, lines 5-40) and Katz also teaches that it is old and well known in the promotion art for users to create a telecommunication minute account for interacting with an Internet website of a seller of good or service (col 6, lines 25-55; see col 9, lines 55-67), such as a clearinghouse of prepaid communication service providers, telecommunication time resellers, wholesalers and financial service institutions (see col 5, lines 5-15). Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the application was made, to know that users of the Hoffman's system would access a retailer's website in order to create or secure a wireless account with a wireless service provider, as taught by Katz in view that said users would be offered free airtime minutes, as an incentive for interacting with said retailer's website.

As per claim 10, Hoffman teaches:

wherein said action on said web site comprises: selection of an electronic advertisement (see column 3, lines 55-67). Purchasing of an item at a website is selecting the item which is also an advertisement.

As per claim 11, Hoffman teaches:

wherein said action on said web site comprises: returning to said web site (see column 4, lines 1-25).

As per claim 12, Hoffman teaches:

wherein said action on said web site comprises: obtaining electronic services (see column 4, lines 1-25).

As per claim 13, Hoffman teaches:

monitoring said web site to determine if said user performs said action on said web site (see column 4, lines 1-25).

As per claim 14, Hoffman does not expressly teach:

creating a wireless service account for said user in response to said user performing said action on said web site. However, Katz teaches providing customer with wireless service accounts (see Katz col 6, lines 40-55). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Hoffman would credit unit-minutes to Katz's recipient accounts in order that said recipient would be able to access to said wireless account to purchase goods or services using said unit-minutes.

As per claim 15, Hoffman does not expressly teach:

crediting said wireless service account with said wireless airtime units. However, Katz teaches providing customer with wireless service accounts (see Katz col 6, lines 40-55). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Hoffman would credit unit-minutes to Katz's recipient accounts in order that said recipient would be able to access to said wireless account to purchase goods or services using said unit-minutes.

As per claim 16, Hoffman does not expressly teach:

crediting said wireless service account when said user purchases wireless airtime units. However, Katz teaches a prepaid card wireless system that allows subscribers to purchase additional wireless minutes (see Katz column 2, lines 15-25).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Hoffman would allow a user to purchase additional wireless minutes, as taught by Katz in order that said user is allowed to continue using a communication device when the user's airtime minutes are already used up.

As per claim 17, Hoffman does not expressly teach:

reducing a count of wireless airtime units in said wireless service account when said user uses a wireless communications device based on said wireless service account. However, the same rejection applied to claim 16 is also applied to claim 17.

As per claim 19, Hoffman does not expressly teach:

creating a phone service account for said user in response to said user accessing said electronic information. However, the same argument made in claim 14 regarding this missing limitation is also made in claim 19.

As per claim 20, Hoffman does not expressly teach:

said wireless account is a metered phone service account. However, the same argument made in claim 14 regarding this missing limitation is also made in claim 20.

4. Claims 1, 2, 5-8, 18, 21-28 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (US 6,424,706) in view of Hoffman (US 6,980,670).

As per claim 1, Katz teaches:

A method of purchasing goods or services, comprising:

creating a wireless service account in response to a user having actively interacted with a given website of a seller of goods or services, that has secured

wireless airtime units from a wireless service provider (col 2, lines 10-25; col 6, lines 25-55; see col 9, lines 55-67)

directing payment for goods or services with said wireless airtime units credited to said wireless service account (see column 4, lines 39-67) but fails to teach *providing attraction to said given web site* by crediting said wireless airtime units to said wireless service account based on an interaction of said entity with a web site of a seller of goods or services. However, Hoffman teaches awarding airtime minutes to users by said users performing action on websites of Internet Reward providers (see Hoffman column 4, lines 3-25; column 5, lines 10-20; col 17, lines 44-60; col 28, lines 45-62; col 32, lines 15-27). Therefore, because users of the Katz system can place orders via online websites (see Katz col 8, lines 15-20), then it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Katz would award users with airtime minutes by said users performing actions on said online websites of Internet reward providers, as taught by Hoffman in order that said users have an incentive to visit said website of said Internet reward providers and purchase products or services from said providers.

As per claim 2, Katz teaches:

said directing payment is for payment of goods (see column 4, lines 39-67).

As per claim 5, Katz teaches:

said directing payment is for payment of a service (see column 4, lines 39-67).

As per claim 6, Katz teaches:



said directing payment transfers wireless airtime units from a buyer's account to a seller's account (see column 4, lines 39-67).

As per claim 7, Katz teaches:

said wireless airtime units can be used in a metered wireless communications system (see column 4, lines 39-65).

As per claim 8, Katz teaches:

said wireless airtime units can be used in post-paid wireless communications system (see column 8, lines 15-33).

As per claim 18, Katz teaches:

A method of conducting e-commerce, comprising:

creating a wireless service account in response to a user having actively interacted with a given website of a seller of goods or services, said seller of goods or services securing wireless airtime units from a wireless service provider (col 2, lines 10-25; col 6, lines 25-55; see col 9, lines 55-67)

crediting a wireless device account associated with said user with a given number of said wireless airtime units (see column 4, lines 39-67) but fails to teach *providing attraction to said given web site* by offering said wireless airtime units to said user in exchange for said user actively interacting with a given web page. However, Hoffman teaches awarding airtime minutes to users by said users performing action on websites of Internet Reward providers (see Hoffman column 4, lines 3-25; column 5, lines 10-20; col 17, lines 44-60; col 28, lines 45-62; col 32, lines 15-27). Therefore, because users of the Katz system can place orders via online websites (see Katz col 8,

lines 15-20), then it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Katz would award users with airtime minutes by said users performing actions on said online websites of Internet reward providers, as taught by Hoffman in order that said users have an incentive to visit said website of said Internet reward providers and purchase products or services from said providers.

As per claim 21, Katz teaches:

A method of paying for an offering, comprising:

creating a wireless service account in response to an entity having actively interacted with a given website of a seller of goods or services, said seller of goods or services securing wireless airtime units from a wireless service provider (col 2, lines 10-25; col 6, lines 25-55; see col 9, lines 55-67);

maintaining a count of said wireless airtime units in said wireless service account associated with an entity (see column 4, lines 39-67); and

reducing said maintained count of wireless airtime units in said wireless service account when said entity exchanges said wireless airtime units for a given good or service (see column 4, lines 39-67). Katz fails to teach *providing attraction to said given web site by crediting said wireless airtime units to a wireless service account based on an interaction of said entity with a web site of a seller of goods or services*. However, Hoffman teaches awarding airtime minutes to users by said users performing action on websites of Internet Reward providers (see Hoffman column 4, lines 3-25; column 5, lines 10-20; col 17, lines 44-60; col 28, lines 45-62; col 32, lines 15-27). Therefore,

because users of the Katz system can place orders via online websites (see Katz col 8, lines 15-20), then it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Katz would award users with airtime minutes by said users performing actions on said online websites of Internet reward providers, as taught by Hoffman in order that said users have an incentive to visit said website of said Internet reward providers and purchase products or services from said providers.

As per claim 22, Katz teaches:

selling a product wherein said product can be purchased in exchange for a predefined number of said wireless airtime units in a wireless service account associated with a purchaser of said product selling said product through a web site (see column 4, lines 39-67; column 8, lines 15-19).

As per claim 23, Katz teaches:

accepting a predefined number of said wireless airtime units in exchange for said offering (see column 4, lines 39-67).

As per claim 24, Katz teaches:

by performing an action on a web site (see Katz col 8, lines 15-20) but fails to teach said wireless airtime units are earned by said action. However, Hoffman teaches awarding airtime minutes to users by said users performing action on websites of Internet Reward providers (see Hoffman column 4, lines 3-25; column 5, lines 10-20; col 17, lines 44-60; col 28, lines 45-62; col 32, lines 15-27). Therefore, because users of the Katz system can place orders via online websites (see Katz col 8, lines 15-20), then it

would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Katz would award users with airtime minutes by said users performing actions on said online websites of Internet reward providers, as taught by Hoffman in order that said users have an incentive to visit said website of said Internet reward providers and purchase products or services from said providers.

As per claim 25, Katz fails to teach:

said wireless airtime units are earned by visiting a web site. However, the same argument made in claim 24 regarding said missing limitation is also made in claim 25.

As per claim 26, Katz teaches:

said wireless airtime units represent metered wireless services (see column 5, lines 40-50).

As per claim 27, Katz fails to teach:

crediting at least one wireless airtime unit to said wireless service account in response to behavior by said entity. However, the same rejection applied to claim 24 regarding this missing limitation is also made in claim 27.

As per claim 28, Katz fails to teach:

crediting one or more wireless airtime units to said wireless service account in response to said entity visiting a web site. However, the same argument made in claim 24 with respect to said missing limitation is also made in claim 28.

As per claim 38, Katz teaches:

An incentive offering system, comprising:

create said wireless service account in response to said entity having actively interacted with said e-tailer web site Wherein said e-tailer secures said wireless airtime units from a service provider (col 2, lines 10-25; col 6, lines 25-55; see col 9, lines 55-67);

a wireless service account associated with an entity, said wireless service account maintaining a count of wireless airtime units (see column 4, lines 39-65) but fails to teach and a processor in communication with both an e-tailer website and said wireless service account, said processor being configured to *provide attraction to said e-tailer website* by increasing said count of wireless airtime units when said entity actively interacts with a given feature of e-tailer web site. However, Hoffman teaches awarding airtime minutes to users by said users performing action on websites of Internet Reward providers (see Hoffman column 4, lines 3-25; column 5, lines 10-20; col 17, lines 44-60; col 28, lines 45-62; col 32, lines 15-27). Therefore, because users of the Katz system can place orders via online websites (see Katz col 8, lines 15-20), then it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Katz would award users with airtime minutes by said users performing actions on said online websites of Internet reward providers, as taught by Hoffman in order that said users have an incentive to visit said website of said Internet reward providers and purchase products or services from said providers.

As per claim 39, Katz fails to teach:

said e-tailer's web site is configured to monitor activity of said entity to determine if said entity has earned offered wireless airtime units; and said e-tailer's web site is

configured to communicate with said processor to update said wireless service account with said earned wireless airtime units. However, the same argument made in claim 38 regarding said missing limitation is also made in claim 39.

As per claim 40, Katz teaches:

said wireless service account is updateable with additionally purchased wireless airtime units (see column 2, lines 1-40) but fails to teach from said e-tailer. However, the argument made in claim 38 regarding said missing limitation is also made in claim 40.

As per claim 41, Katz teaches:

said wireless service account is updateable with additionally purchased wireless airtime units from said wireless service account (see column 2, lines 3-42).

### ***Response to Arguments***

5. Applicant's arguments filed 09/16/2008 have been fully considered but they are not persuasive. The Applicant argues that the Examiner withdraw the section 101 rejection. The Examiner answers that the rejection is not withdrawn based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).

The Applicant argues that the prior arts do not teach "providing attraction to a website". The Examiner answers that Hoffman providing free airtime minutes to users

that interact with a retailer website (see col 4, lines 20-25) is providing attraction to a website. Therefore, contrary to Applicant's argument, the prior arts teach Applicant's claimed invention.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/  
Examiner, Art Unit 3688  
November 28, 2008